

REMARKS/ARGUMENTS

I. Amendments to the Specification

With this Response, Applicants present a plurality of amendments to the specification to rectify clerical errors. No new matter is added.

II. Status of the Claims

Applicants received the Office Action dated December 1, 2005, in which the Examiner rejected claims 1, 3-6 and 8-11 under 35 U.S.C. § 102(e) as being unpatentable over Peters (U.S. Patent No. 6,920,555). The Examiner also rejected claims 26-30 under 35 U.S.C. § 102(e) as being unpatentable over Tone (U.S. Patent No. 6,640,306). The Examiner further rejected claims 2, 7 and 12-25 under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Herle (U.S. Patent Application No. 2004/0261073). With this Response, Applicants amend claim 20 to correct a typographical error. The amendment does not narrow the scope of claim 20, nor does the amendment narrow the scope of any claim that depends on claim 20. Based on the arguments contained herein, Applicants believe this case to be in condition for allowance.

A. Rejections under § 102(e)

i. Rejection of Claims 1, 3-6, 8-11 under Peters

The Examiner rejected claims 1, 3-6, and 8-11 as unpatentable over Peters, but Applicants find it difficult to understand the Examiner's arguments. Applicants respectfully request clarification as to how the Examiner reads Peters on claims 1, 3-6 and 8-11. Nonetheless, in the interest of compact prosecution, Applicants attempt to address the Examiner's rejections.

Peters is directed to a technique for migrating computer system data (e.g., user profiles) from one image (e.g., operating system) to another. Peters discloses selecting the data to be migrated, preparing space in a storage partition to store the data, replacing an image with a new image, and subsequently loading the data from the storage partition to the new image. In this way, the computer system is configured not only with a new image, but also with the data from the replaced image.

Claim 1 requires "generating a device-bound certificate ("DBC")..." The Examiner cites Figure 1 and column 13, lines 21-36 of Peters as disclosing this requirement. Applicants traverse this assertion and respectfully submit that Peters does not disclose here or elsewhere the generation of a DBC. Instead, referring to Figure 1 of Peters, there is shown a computer system 100 comprising a partitionable storage 102, a processor 110, memory 112, input/output devices 114 and a network I/O 116. The storage 102 contains an OS 104, user settings 106 and user data 108. There is no mention or suggestion of generating a DBC. Although column 13, lines 21-36 disclose the use of security IDs (SIDs) which are part of "a copy authentication process which discourages unauthorized copying of Microsoft operating systems," there is still no disclosure of "generating a DBC" as required by claim 1.

Not only does Peters fail to disclose the generation of a DBC, but Peters also fails to disclose a DBC "comprising an authentication code generated using a hashed message authentication code algorithm and a key specific to [a] device," as required by claim 1. The Examiner cites Figure 1 and column 13, lines 21-36 as disclosing this requirement. Applicants traverse this assertion and respectfully submit that Peters does not here or elsewhere disclose this requirement. Instead, as mentioned above, Figure 1 simply provides a block diagram of a computer system 100 which does not disclose the generation of a DBC, nor does it disclose a DBC that comprises an authentication code generated using "a hashed message authentication code algorithm and a key specific to said device." Likewise, column 13, lines 21-36 disclose subject matter as described above, none of which refers to the generation of a DBC or a DBC comprising the "authentication code generated using a hashed message authentication code algorithm and a key specific to said device."

Further still, Peters does not disclose "storing the DBC in [a] boot image," as is also required by claim 1. The Examiner cites Figure 1 (elements 100 and 112), column 4, lines 18-31, and column 13, lines 21-36 as disclosing this limitation. Applicants respectfully traverse this assertion and submit that Peters does not here or elsewhere disclose this limitation. Applicants already have established that Figure 1 and column 13, lines 21-36 fail to disclose a DBC. Column 4, lines 18-31 provide a basic description of

Figure 1. No teaching or suggestion is made regarding a DBC. Thus, because Peters fails to disclose a DBC, Peters cannot, and does not, disclose "storing the DBC" in a boot image.

No other art of record satisfies the deficiencies of Peters. For any or all of these reasons, claim 1 and its dependent claims 2-10 are patentable. Further, because independent claim 11 comprises limitations similar to those of claim 1, independent claim 11, as well as its dependent claims 12-19, also are patentable for the same or similar reasons as for claim 1. Claims 1-19 also may be patentable for reasons not specifically discussed. Accordingly, Applicants respectfully request that the rejections against claims 1-19 be withdrawn and the claims allowed.

ii. Rejection of Claims 26-30 under Tone

The Examiner rejected claims 26-30 as unpatentable over Tone, but Applicants find it difficult to understand the Examiner's arguments. Applicants respectfully request clarification as to how the Examiner reads Tone on claims 26-30. Nonetheless, in the interest of compact prosecution, Applicants attempt to address the Examiner's rejections.

Tone is directed to a technique for preventing the unauthorized copying and sharing of music files among users of portable music devices. Each music device is hard-coded with a unique ID. A user of the music device is able to download music files from a central system via, for example, the Internet. When the user desires to download a particular music file from the central system, the music device sends a request signal to the central system. The request signal contains the music device's unique ID. In turn, when the central system receives the request signal, the central system transfers a copy of the requested music file to the music device. Before sending the music file to the device, the central system inserts the ID of the music device into the music file. The music file is received by and stored on the music device. When the user attempts to play the music file, the music device first compares the ID of the music device to the ID of the music file to ensure that the IDs match. A matching ID indicates that the music device is permitted to play the music file (e.g., the music file has probably been obtained legally), and so the music device plays the file. However, if the ID of the file does not match the ID

of the device, an alert is generated, since the music device is not authorized to play the music file (e.g., the music file has probably been obtained illegally).

Claim 26 requires "a boot image." The Examiner cites Figures 1 and 7 and column 7, line 49 – column 8, line 12 as disclosing this requirement. Applicants traverse this assertion. Figure 1 comprises a basic block diagram showing a receiving unit 2, a portable terminal unit 1 that fits into the receiving unit 2, and a transmitting unit 3 coupled to the receiving unit 2 via a server 3A and/or a communication circuit 5. Nowhere is a "boot image" disclosed. Likewise, Figure 7 shows a more detailed version of Figure 1. Various components of the units 1, 2 and 3 are disclosed, none of which constitute a "boot image," as required by claim 26. Similarly, column 7, lines 49-59 describe the ID that is attached to music files transferred from unit 3 to unit 1, and column 7, line 60 – column 8, line 12 describe communications between the units 1, 2 and 3. A "boot image" still is not disclosed.

Claim 26 also requires a "flash memory." The Examiner asserts that element 1 of Figure 1 and elements 1 and 28 of Figure 7 disclose this requirement. Applicants traverse this assertion. Element 1 of Figure 1 comprises a portable terminal unit (e.g., music device). A portable terminal unit does not constitute flash memory. Likewise, elements 1 and 28 of Figure 7 refer to the portable terminal unit and a random access memory (RAM), respectively. Again, neither the portable terminal unit nor the RAM constitutes flash memory.

Moreover, because Tone fails to disclose a flash memory or a boot image, Tone also fails to disclose "a boot image bound to said flash memory using an authentication code generated by way of a hashed message authentication code algorithm and a key specific to said device," as further required by claim 26. The Examiner asserts that Figures 1 and 7 and column 7, line 49 – column 8, line 12 disclose this requirement. Applicants traverse this assertion. The teachings of Figures 1 and 7 and column 7, line 49 – column 8, line 12 are discussed above. A boot image bound to a flash memory as required by claim 26 is not disclosed. At best, Tone teaches the use of the IDs, as previously explained, to prevent the unauthorized copying and sharing of music files between music devices. However, this basic technique may not provide the same level of

protection afforded by the more sophisticated "authentication code generated by way of a hashed message authentication code algorithm and a key specific to said device," as required by claim 26.

Claim 26 is still further patentable over Tone because Tone fails to disclose an "OMAP processor." The Examiner asserts that element 1 of Figure 1 and elements 1, 27 and 28 of Figure 7 constitute OMAP processors. Applicants traverse this assertion. Element 1 of Figures 1 and 7 consists of a portable terminal unit. Elements 27 and 28 of Figure 7 consist of a ROM and a RAM, respectively. Nowhere in Tone is an OMAP processor taught or suggested.

No other art of record satisfies the deficiencies of Tone. For any or all of these reasons, claim 26 and its dependent claims 27-30 are patentable. Claims 26-30 also may be patentable for reasons not specifically discussed. Accordingly, Applicants respectfully request that the rejections against claims 26-30 be withdrawn and the claims allowed.

B. Rejection of Claims 2, 7, 12-25 under § 103(a)

The Examiner rejected claims 2, 7, and 12-25 as unpatentable over Peters in view of Herle, but Applicants find it difficult to understand the Examiner's arguments. Applicants note that the Examiner rejected claims 2, 12-17, 20 and 22-25 because "Peters discloses all the subject matters, except for using an Open Multimedia Applications Plattform (sic) ("OMAP") read-only memory ("ROM") code." The Examiner goes on to assert that Herle discloses such a limitation.

In response, however, Applicants point out that of these claims cited by the Examiner, it is only claim 2 that explicitly requires "an OMAP ROM code." Claims 12-17 require "an OMAP processor comprising a ROM code..." because they depend on claim 11, and claims 20 and 22-25 make no mention of OMAP or ROM code at all. Applicants address the claims in turn.

i. Claim 2

As mentioned, claim 2 requires "an OMAP ROM code." The Examiner fails to establish a *prima facie* case of obviousness, the standard for which is set forth below:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

MPEP 2142 (emphasis added). Neither Peters nor Herle teaches or even suggests an "OMAP ROM code," as required by claim 2. Instead, Herle is directed to a technique whereby mobile communication systems, such as cell phones, are provided with software updates in a fail-safe manner. Referring to Figure 2 of Herle, the Examiner cites the mobile phone 111, the flash memory 280 as reading on claim 2. Referring to Figure 3 of Herle, the Examiner cites ROM code 310 as reading on claim 2. Applicants traverse these assertions and respectfully point out that none of a mobile phone, flash memory or ROM code constitutes an "OMAP ROM code," as required by claim 2. Peters also fails to teach this requirement, as admitted by the Examiner in the Office Action. Because neither Peters nor Herle teaches this requirement, the Examiner fails to establish a prima facie case of obviousness. At least for this reason, claim 2 is patentable over the combination of Peters and Herle. Claim 2 is further patentable because it depends on independent claim 1, which is patentable for the reasons set forth above. For any or all of these reasons, Applicants respectfully request that the rejection against claim 2 be withdrawn and the claim allowed.

ii. Claims 12-19

Claim 11 requires "an OMAP processor comprising a ROM code..." and because claims 12-19 depend on claim 11, claims 12-19 also require this limitation. The Examiner fails to establish a prima facie case of obviousness because neither Peters nor Herle teaches or even suggests this limitation. While both Peters and Herle teach processors (i.e., processor 110 of Peters and processor 240 of Herle), nowhere is "an OMAP processor" mentioned. Because an OMAP processor is not mentioned, an "OMAP processor comprising a ROM code" cannot and is not mentioned, either. Claims 12-19 thus are patentable over the combination of Peters and Herle. Claims 12-19 are further patentable because they depend on independent claim 11, which is patentable for the

reasons previously discussed. For any or all of these reasons, Applicants respectfully request that the rejections against claims 12-19 be withdrawn and the claims allowed.

iii. Claims 20-25

As mentioned, the Examiner has made an erroneous reading of claims 20 and 22-25 in that claims 20 and 22-25 do not make any mention of "OMAP" or "ROM code." The Examiner provides no other reason for rejecting claims 20 and 22-25 under the combination of Peters and Herle. At least for this reason, claims 20 and 22-25 are patentable over the combination of Peters and Herle, and because claim 20 is patentable over the combination of Peters and Herle, dependent claim 21 also is patentable over this combination. Claims 20-25 thus are patentable over the combination of Peters and Herle.

In addition, claims 20-25 are further allowable over the combination of Peters and Herle because the Examiner fails to establish a prima facie case of obviousness. In particular, Applicants respectfully submit that Peters and Herle, when taken alone or in combination, fail to teach all of the limitations of claim 20. Claim 20 requires "generating a device-bound certificate ("DBC")," where the DBC comprises "an authentication code generated using a hashed message authentication code algorithm and a key specific to [a] medium." Claim 20 also requires "storing the DBC on a boot image." As explained above in the context of claims 1 and 11, Peters fails to teach these requirements.

Like Peters, Herle also fails to teach these requirements. Instead, Herle is directed to a technique whereby mobile communication systems, such as cell phones, are provided with software updates in a fail-safe manner. Nowhere does Herle teach or even suggest a DBC or "an authentication code generated using a hashed message authentication code algorithm and a key specific to [a] medium," as required by claim 20. Herle also fails to teach "storing the DBC on a boot image."

Because Peters and Herle, whether taken alone or in combination, fail to teach these limitations, the Examiner fails to establish a prima facie case of obviousness. For any or all of the reasons set forth above, claim 20 and its dependent claims 21-25 are patentable. Claims 20-25 also may be patentable for reasons not specifically discussed. Accordingly, Applicants respectfully request that the rejections against claims 20-25 be withdrawn and the claims allowed.

iv. Claim 7

Because claim 7 comprises limitations similar to those of claim 20, and further because claim 7 depends on independent, patentable claim 1, claim 7 also is allowable over the combination of Peters and Herle. Accordingly, Applicants respectfully request that the rejection against claim 7 be withdrawn and the claim allowed.

III. Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case. If any fees or time extensions are inadvertently omitted or if any fees have been overpaid, please appropriately charge or credit those fees to Conley Rose Deposit Account Number 03-2769 and enter any time extension(s) necessary to prevent this case from being abandoned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Nick P. Patel", is written over a horizontal line.

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